

USSN: 09/439,429  
Attorney Docket No: 3045.00004

REMARKS

Claims 3, 4, 7, 8, and 10-16 are currently pending in the application. Only claims 3 and 13 are in independent form.

Applicants wish to express their appreciation for the courtesies extended Applicants' representative, Amy E. Rinaldo, during a telephonic interview conducted in August 2003.

Claims 8 and 10-12 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Office Action states that claim 8 includes limitations that have no antecedent basis. Claim 8 has been amended to provide proper antecedent basis for all of the limitations and reconsideration of the rejection is respectfully requested.

The Office Action states that claims 10-12 include limitations that do not have proper antecedent basis. Accordingly, claims 10-12 have been amended to provide proper antecedent basis and reconsideration of the rejection is respectfully requested.

Claims 3-4, 7-8, 10 and 13-16 stand rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for inhibiting the expression of TNF- $\alpha$  *in vitro* does not reasonably provide enablement for modulating, which includes enhancing and inhibiting expression of TNF- $\alpha$ , *in vivo*. In order to further prosecution, the claims have been amended, without prejudice, to be limited to such modulation *in vitro* and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not discussed above are ultimately dependent upon the independent claims discussed above. No prior art reference makes up for the deficiencies of that reference as applied against the independent claims as no prior reference discloses or suggests the invention as set forth in the independent claims, as discussed in detail above. Such a combination of references that derive the present invention can only be made through hind sight as no prior art reference discloses or even suggest the fusion protein of the present invention, as discussed in detail above.

It is respectfully requested that the present amendment be entered in order to place the application in condition for allowance or at least in better condition for appeal. The application is placed in condition for allowance as it addresses and resolves each and every issue that remains pending. The amendments overcoming the rejections under 35 U.S.C. 112 are made exactly as suggested by the Office Action. Claims have also been amended to clearly distinguish over the prior art. The application is made at least in better condition for appeal as

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the amendment removes many issues thereby simplifying the issues on appeal. That is, each and every rejection under 35 U.S.C 112 has been overcome exactly as suggest in the Office Action. Further, the claims have been amended to more specifically define the invention while raising no new issues, which would require any further searching. Rather, the amendments have been made in view of comments made in the Office Action, which clearly distinguish the presently pending claims over the cited prior art. Hence, it is respectfully requested that the amendment be entered.

This amendment could not have been made earlier as the amendment corrects typographical errors in the claims in accordance with the suggestion made in the Office Action, the suggestion first being made in the outstanding Office Action. Hence, since there remains no further issues to be resolved, it is respectfully requested that the present amendment be entered.

In conclusion, it is respectfully requested that the present amendment be entered in order to place the application in condition for allowance, which allowance is respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

In view of the above, the application is in condition for allowance which allowance is respectfully requested.

If any remaining issues exist, Applicants respectfully request to be contacted by telephone at 248-539-5050.

Respectfully submitted,

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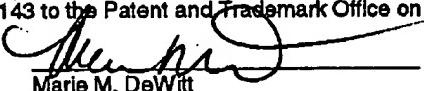
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I hereby certify that this correspondence is being transmitted via facsimile (703) 746-5143 to the Patent and Trademark Office on October 8, 2003.



Marie M. DeWitt